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EXAMINER

WERNER, BRIAN P

ART UNIT PAPER NUMBER

2621

DATE MAILED: 03/05/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

*Re*  
*Blue*

## Office Action Summary

**Application No.**

09/460,965

**Applicant(s)**

XUE, NING

**Examiner**

Brian P. Werner

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. This Office Action is responsive to the "response" and "declaration" received on December 15, 2003. Claims 1-20 remain pending.
2. The "Declaration of Prior Invention" filed on December 15, 2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the Westerman (US 6,529,638 B1) reference. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Westerman reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). An explanation shall follow.

MPEP 715.07 (Fact and Documentary Evidence) states that the applicant can establish prior invention by sufficiently showing "conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice)." This is the situation of the instant application. That is, the applicant has attempted to pre-date the Westerman reference, US 6,529,638 B1, filed on February 1, 1999, by a showing of conception and due diligence.

MPEP 715.07(a) states that "... diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established." In the case of the applicant's 131 declaration, conception has not been adequately shown, as described below, and thus diligence does not come into question yet.

The applicant's 131 declaration comprises six (6) assertions at page 2, and two exhibits labeled Exhibit A and Exhibit B. It appears that assertion "2" (page 2 of the declaration), Exhibit A alleges evidence of conception prior to February 1, 1999. Exhibit B appears to be related to due diligence, which is not in question yet.

The contents of Exhibit A are unclear. That is, Exhibit A appears to contain four (4) entirely different documents:

- The first two (2) pages of Exhibit A appear to be an internal "Invention Disclosure Form", signed by two (2) inventors (only one of which is an inventor listed on the instant application), and listing a testing date of "July, 99". This document does not seem to provide evidence of conception before February 1, 1999. Further, this document is not specifically referred to or described at page 2 of the declaration, and it is not specifically dated per se.
- The next three (3) pages appear to be an entirely different document, labeled at the top of that page as "Purpose and Development", and specifically titled "Anti-block noise Filter: algorithm and implementation". The document comprises

pages "1 of 3", "2 of 3" and "3 of 3" at the bottom right hand corner of each page.

Again, this document is signed by two inventions (only one of which is the inventor listed on the instant application), it is not specifically referred to or described at page 2 of the declaration, and it is not dated. Furthermore, while the document describes the purpose and benefits of the invention, the document does NOT describe how the invention is implemented. It certainly does not describe the all of the claim limitations. The examiner is uncertain what this document proves.

- The next six (6) pages appear to be a series of twelve (12) slides, labeled "1/12" through "12/12" at the bottom right corner of each. The first slide (i.e., slide "1/12") is titled "Anti-block noise filter design review", and it appear to be authored by two people. The first author is the single named inventor of the instant application, and the second author is block out, and therefore illegible. It is unclear what relation these slides bear with the previous documents or where they fall out in the timeline. However, the slides do appear to describe and depict some, but not all, of the applicant's disclosed and claimed invention. However, this document it is not specifically referred to or described at page 2 of the declaration, and it is not dated. Furthermore, it does not describe the all of the claim limitations. The examiner is uncertain what this document proves.

- Finally, the last two (2) pages appear to depict block diagrams of a system, without a corresponding written description what those diagrams are doing. This document is not signed by any inventors, it is not specifically referred to or described at page 2 of the declaration, and it is not dated. Furthermore, the document does NOT describe how the invention is implemented, and it certainly does not describe the all of the claim limitations. The examiner is uncertain what this document proves.

The relationship between the four (4) separate documents that comprise Exhibit A is unclear, the dates of each of the documents is unclear, the applicant does not describe the relevance of each of the documents, and the documents either individually or collectively do not appear to describe all of the claim limitations.

MPEP 715.07 states that "conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc ... [and] conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also." In the case of Exhibit A, it is unclear which one of the four (4) separate documents therein proves comprehension of "the means themselves and their interaction". Even if one or more of the documents did prove such comprehension, the date of the document is unclear. While applicant makes a general assertion at page 2 of the declaration that "a written description of the invention was prepared prior to February 1, 1999", as "evidenced by the Invention Disclosure (Exhibit A)", Exhibit A contains more than one document; and

Art Unit: 2621

at least one of those documents could not have been written prior to February 1, 1999 (i.e., the first two (2) pages of Exhibit A cites a test data of "July, 99"). Therefore, the question arises as to which of the four (4) document of Exhibit A that applicant is referring when he asserts that the "invention was prepared prior to February 1, 1999."

MPEP 715.07 further states, "each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show." This is clearly not the case as described above. Exhibit A comprise four (4) separate documents, none of which are "specifically referred to in the ... declaration", especially "in terms of what it is relied upon to show."

MPEP 715.07 further states, "an accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself." As stated above, all of the claim limitations are not described in Exhibit A. Further, the declaration fails to provide any "missing limitations".

MPEP 715.07 further states, "the affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date." The applicant's affidavit does not clearly explain which facts he is relying upon to show completion. Which of the four (4) separate documents in Exhibit A are being relied upon, and which of those documents pre-date February 1, 1999? The first document appears not to pre-date February 1, 1999.

MPEP 715.07 further states, "vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by

proof or a showing of facts ...” The applicant’s declaration and Exhibit A are tantamount to general assertions and broad statements. For example, page 2 of the declaration asserts that “completion of the invention” is established “at a date prior to February 1, 1999”, and that “As evidenced by the Invention Disclosure (Exhibit A), prepared, witnessed and signed by the two named inventors, a drawing and a written description of the invention was prepared prior to February 1, 1999.” However, only one of the four (4) separate documents of Exhibit A is titled “Invention Disclosure Form”, and it cites a test date of “July, 99”. The other three (3) documents are not specifically referred to, and the examiner cannot assumed that they too are the “invention disclosure” referred to by the declaration. Further, given that the first document of Exhibit A establishes a testing date of “July 99”, this raises a question as to which of the other three (3) documents are alleged to pre-date February 1, 1999.

MPEP 715.07 further states that “applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant.” The applicant has not done this, as described above.

In summary, a concise explanation of each of the four (4) separate documents contained in Exhibit A is required, where the applicant points out what facts therein are established and relied upon. Further, is should be made clear which of those four (4) documents pre-date February 1, 1999. Presently, this is unclear because at least one of those documents was created on or after “July, 99” (i.e., the first document of Exhibit A). Finally, which of those four (4) documents proves conception of the invention and describes all of the claim limitations. For example, which document and which page



Art Unit: 2621

describes the claim limitation of "determining whether a predetermined condition is satisfied" (e.g., claim 1), and where the "determining step being based upon at least a result of said average variance and average mean calculating step" (claim 4)?

### ***Inventorship***

3. The 131 declaration and Exhibit A described above lists two inventors that appear to be affiliated with conceiving and reducing the instant invention to practice. However, only one of the two inventors is listed as an inventor on the instant application (i.e., "Ning Xue"). This raises a question of inventorship, and the examiner hereby requests that the applicant's review the inventorship of the instant application, and make any necessary corrections. This is not a formal rejection or objection.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2-4, 9-11 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 2 requires "said determining step being based upon at least a result of said average mean calculating step." Claim 3 requires "said determining step being based upon at least a result of said average variance calculating step." Claim 4 requires "said determining step being based upon at least a result of said average variance and average mean calculating step." Claims 9-11 recite equivalent limitations to those of claims 2-4 respectively. Claim 16 recites limitations equivalent to claim 4. Because the issues are all the same, claim 4 will be used to exemplify the rejection.

Claim 4 requires the determining of whether a predetermined condition is satisfied based on a result of calculating an average variance and an average mean. The original specification does not link the "predetermined condition" determination with the calculation of the "variance" and "mean". That is, the original specification states on several occasions that the satisfaction of a predetermined condition is determined (i.e., at page 7, line 28, page 8, lines 9 and 31 and page 9, line 7). However, the specification never mentions that the determination is based on a "mean" calculation, a "variance" calculation, or both.

The following quotations regarding the written description requirement of original claims are extracted verbatim from MPEP 2163:

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116. >However, a showing of possession alone does not cure the lack of a written description. *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 296 F.3d 1316, 1330, 63 USPQ2d 1609, 1617 (Fed. Cir. 2002).<

Art Unit: 2621

A question as to whether a specification provides an adequate written description may arise in the context of an original claim which is not described sufficiently (see, e.g., > *Enzo Biochem*, 296 F.3d at 1329, 63 USPQ2d at 1616 (Fed. Cir. 2002); < *Eli Lilly*, 119 F.3d 1559, 43 USPQ2d 1398), a new or amended claim wherein a claim limitation

However, as discussed in paragraph I., *supra*, the issue of a lack of adequate written description may arise even for an original claim when an aspect of the claimed invention has not been described with sufficient particularity such that one skilled in the art would recognize that the applicant had possession of the claimed invention. The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art. For example, consider

From these citations, it is clear that a written description rejection is appropriate for original claims when the claimed invention has not been described with sufficient particularity such that one skilled in the art would recognize that the applicant had possession of the claimed invention; especially where an essential or critical feature is not adequately described which is not conventional or known. In the case of claim 4, the feature is critical (i.e., the determination of whether a predetermined condition is satisfied is critical to the invention as it is a key step in the independent claims). Given that the specification does not describe the aforementioned limitation at all, it is the examiner's contention that it is not adequately described.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Westerman (US 6,529,638 B1).

Regarding claim 1, Westerman discloses a method comprising:

partitioning an image into two or more sub-blocks (figure, the image is partitioned in to 8X8 sub-blocks; see column 4, line 29), each containing a predetermined number of pixels (8 x 8) where a boundary between the two sub-blocks is defined (figure 1, numeral 6; "boundary" at column 4, line 47), each pixel having a value ("intensities" at column 4, line 47; the intensities are designated by the "h" numbers in figures 1 and 2);

determining whether a predetermined condition is satisfied (this is met by the reference in at least two different ways: First, a pixel must be "near the block boundary 6" at column 4, line 47; the entire disclosed process of adjusting pixel values is predicated upon this determination; Second, the condition of comparing the variances at figure 2, numeral 44 with the thresholds "t" at figure 2, numeral 46 must be satisfied before the pixel adjustment can commence; i.e., the condition that the variance must be

Art Unit: 2621

placed in one of four bins based on a comparison with a threshold "t" must be satisfied);  
and

upon satisfaction (e.g., if a pixel is near the block boundary), at least for a first pixel disposed proximal to the boundary (e.g., "h2"), recalculating the pixel video value for the first pixel (column 5, line 40, "h2" is recalculated based on the equation) based on the pixel video value of a second pixel disposed proximal to the first (in the equation at column 5, line 40, the new pixel value for h2 is calculated based on the neighboring pixels of h1, h3 and h4).

Regarding claims 2-4, the determining step (e.g., the condition that the variance must be placed in one of four bins based on a comparison with a threshold "t" must be satisfied) is based upon at least a result of the calculation of a variance (figure 2, numeral 44) and a mean (figure 2, numeral 42) (Note: the specification makes no distinction between an "average" mean or variance, from the well know mathematical definitions of a mean and a variance).

Regarding claim 5, the second pixel is disposed in a different sub-block from the first (i.e., as depicted in figures 1 and 2, pixel "h4" which is a second pixel as described above is disposed in the sub-block to the right of the pixel "h2" that is being adjusted).

Regarding claim 6, both horizontal and vertical algorithms are disclosed ("horizontal and vertical" at column 6, line 60; the horizontal and vertical algorithms are depicted in figure 1).

Regarding claim 7, a predetermined number of pixels is disclosed (i.e., four (4) pixels as described in the equation at column 4, line 57, and as depicted in figures 1 and 2).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Westerman (US 6,529,638 B1) and Andrew (US 6,563,958 B1).

Claims 8-14 recite a computer readable medium storing computer implemented steps equivalent to those of claims 1-7 above. Claims 15-20 recite an apparatus for performing a method equivalent to claims as discussed in the 102 rejection above.

While Westerman teaches those steps, Westerman does not teach a computer readable medium implementing those steps in apparatus.

Andrew discloses a computer implemented system (i.e., apparatus) for performing the exact same process of filtering boundaries and removing block artifacts, comprising a computer readable medium containing instruction causing the computer to performs the boundary filtering steps (i.e., figure 6). Regarding claims 18 and 20 specifically, Andrew teaches a means for reading a video (figure 6, numeral 614 and 612), a mean for filtering (numeral 604) and a means for displaying (numeral 616).

Art Unit: 2621

Regarding the means plus function language, applicant's disclosed structure is that of a computer implemented invention (i.e., refer to applicant's specification at page 4, lines 5 and 6). The Andrew system teaches equivalent structure.

It would have been obvious at the time the invention was made to one of ordinary skill in the art to implement the method of Westerman using a computer implemented system as taught by Andrew, in order to ensure a high computational speed, the capability of program algorithm modification without changing hardware, and to provide the ability for the filtering algorithm to be disseminated and used by the millions of people who have access to computers.

### ***Response to Arguments***

10. Each of the remarks and/or arguments contained in the aforementioned "response" have been considered:

#### **Claim 112 rejection advanced in paragraph 2 of the previous Office Action:**

Summary of Applicant's Remarks: "Applicant respectfully submits that claims 2-4, 9-11 and 16 have been described in the specification" and "each of the elements of the claims have been described in the specification" (response page 2).

Examiner's Response: Where? These assertions are unsupported by evidence. The applicant has not pointed to any sections of the specification where support can be found. Rather than merely stating that the claim elements at issue are disclosed in the

Art Unit: 2621

specification, the examiner respectfully request that the applicant point to specific sentences or paragraphs where the elements are disclosed.

Summary of Applicant's Remarks: "... it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art (that an applicant)<sup>1</sup> had possession of the concept of what is claimed. *Ex parte Parks* ..." (response page 2)<sup>2</sup>.

Examiner's Response: Claim 4 (for example) requires the determining of whether a predetermined condition is satisfied based on a result of calculating an average variance and an average mean. The original specification does not link the "predetermined condition" determination with the calculation of the "variance" and "mean". That is, the original specification states on several occasions that the satisfaction of a predetermined condition is determined (i.e., at page 7, line 28, page 8, lines 9 and 31 and page 9, line 7). However, the specification never mentions that the determination is based on a "mean" calculation, a "variance" calculation, or both.

First, it remains unclear what sections of the specification would have conveyed to one having ordinary skill in the art that the applicant had possession of the concept of what is claimed. Again, applicant's assertion is completely unsupported by evidence. It's not enough to merely state that the specification would have "conveyed" this to one skilled in the art. How does the specification convey this? What sections of the

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<sup>1</sup> Page 1237 of the decision was misquoted.

<sup>2</sup> This quote actually derives from *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).



Art Unit: 2621

specification do the conveying? Where is support for this limitation found (either explicitly or implicitly)? Evidence of this assertion is respectfully requested.

Second, the *Ex parte Parks* decision is not relevant to the fact situation surrounding the 112 rejection advanced herein. In the *Parks* decision, the examiner had rejected claims under 112 first, written description because of the introduction of the negative limitation "in the absence of a catalyst", where the negative limitation did not have literal support. Evidence was provided via an expert that "on having ordinary skill in the art would have recognized that the reaction generating nitric oxide, according to the equation disclosed in the '562 patent, is conducted without a catalyst" (decision page 1237). The *Parks* situation is entirely different, because an equation was pointed to that would have conveyed to one skill in the art support for a negative limitation. In the applicant's situation, a positive limitation requiring a "predetermined condition" be satisfied based on a result of calculating an average variance and an average mean. There are no equations in the disclosure, and applicant has not pointed to any sections of the specification that would have conveyed to one skilled in the art that the applicant had possession of the invention. Thus, the *Parks* decision is not a relevant citation (at least in the absence of any evidence presented by the applicant; and none has been presented). **Again, the applicant has not pointed to a single sentence in the specification where support can be found (implicit, explicit, or otherwise).**

Summary of Applicant's Remarks: "Further, claims themselves have been constituted to provide the description of the invention. *In re Gardner* ..." (response page 2).

Examiner's Response: A written description rejection of original claims is not improper in every circumstance, and *In re Gardner* is not relevant to the current fact situation. First, the MPEP recognizes that original claims may be rejected as lacking a written description. Chapter 2163(I)(a) states:

"... the issue of written description may arise even for an original claim when an aspect of the claimed invention has not been described with sufficient particularity such that one skilled in the art would recognize that the applicant had possession of the claimed invention. That claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art."

Claim 4 for example requires determining of whether a predetermined condition is satisfied based on a result of calculating an average variance and an average mean. This "predetermined condition" is critical to the invention; it is not a trivial or ancillary feature. However, while the specification mirrors the claim language, the specification does not link the "predetermined condition" determination with the calculation of the "variance" and "mean". This examiner contends that such a specific and critical feature must have adequate written description support; and thus far, the applicant has not pointed to any sections of the specification where support in any form can be found. Second, the Guidelines for Examiner of Patent Applications Under the 35 U.S.C. 112,

¶ 1, "Written Description" Requirement, published in the Federal Register, Vol. 66. No. 4, Friday, January 5, 2001 (referred to herein as the "Guidelines") also recognizes that original claims may be rejected as lacking a written description. Section I(A) of the Guidelines is titled "Original Claims", and it mirrors the MPEP (or vice versa). Third, in the Gardner decision quoted by the applicant, the question arose as to whether a "particular subgenus now being claimed" had adequate written description support in the specification disclosure of "a much broader class of compounds" (decision page 150). This situation is not at all similar to the situation of the 112 rejection advanced by the examiner herein. The 112 rejection advanced here is not based on a subgenus claim. Rather, the examiner is question written description support for a critical element of the claimed invention as described above. The Gardner decision is not relevant to the fact situation herein.

In summary, the examiner has make a prima facie case for written description, and the burden has now shifted to the applicant. The examiner has relied upon MPEP chapter 2163, The Written Description Requirement, as well as the Guidelines for Examiner of Patent Applications Under the 35 U.S.C. 112, ¶ 1, "Written Description" Requirement, published in the Federal Register, Vol. 66. No. 4, Friday, January 5, 2001 (referred to herein as the "Guidelines"). In order to demonstrate a lack of written description, the examiner is faced with the task of proving a negative. That is, the examiner must show that the claimed subject matter is NOT present in the specification. In the case of claim 4 (and the other claims rejected herein), the elements recited therein are not depicted in the originally filed drawings, and they are not described by

Art Unit: 2621

the words of the specification. Furthermore, to date the applicant has made absolutely no attempt to show where written description support can be found. Traversal of the written description rejection is simple. According to the MPEP and the Guidelines as stated above, the written description requirement is satisfied when a patent "specification" describes the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention, and to show possession, the specification must describe the claimed invention with all of its limitations using words, structures, figures, diagrams and formulas that full set forth the claimed invention. **Therefore, to show possession, the applicant need only point to a section, or even a sentence, in the specification that implicitly, explicitly or in some other manner supports the limitations at issue. Which sections of the specification would convey to one skill in the art that the applicant had possession of the claimed invention?**

Prior Art Rejections:

No specific argument are advanced for the prior art. Instead, the applicant is relying upon a 131 declaration to pre-date the Westerman reference. However, the declaration is insufficient as described above.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as anticipating many, if not all of the claimed limitations:

- Hu et al., Removal of Blocking and Ringing Artifacts in Transform Coded Images (see figure 3).
- Lee et al., Blocking Effect Reduction of JPEG Images by Signal Adaptive Filtering (see figures 3 and 4).
- Jass (US 4,941,043 A) at figures 2, 5 and 6.
- Kim (US 5,475,434 A) at figures 5, 6 and 9-12.
- Fukunda (US 5,625,714 A) at figures 2-4, 14 and 17.
- Lee (US 6,167,164 A) at figures 2, 3 and 6.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2621


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Werner whose telephone number is 703-306-3037. The examiner can normally be reached on M-F, 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H. Boudreau can be reached on 703-305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian Werner  
Primary Examiner  
Art Unit 2621  
March 3, 2004



**BRIAN WERNER**  
**PRIMARY EXAMINER**